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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,433	04/20/2001	Claude Jarkae Jensen	10209.56	1737
21999 7590 05/05/2009 KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111				
EXAMINER				
YU, GINA C				
ART UNIT		PAPER NUMBER		
1611				
MAIL DATE		DELIVERY MODE		
05/05/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/839,433

**Applicant(s)**

JENSEN ET AL.

**Examiner**

GINA C. YU

**Art Unit**

1611

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 7, 8, 11, 12, 22 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 8, 11, 12, 22, and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Applicant is advised that the Notice of Allowance mailed on March 24, 2009 is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Prosecution on the merits of this application is reopened on claims 1, 7, 8, 11, 12, 22, and 27 as these claims are considered unpatentable for the reasons indicated below:

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 4, 2009 has been entered.

#### ***Claim Objections***

Claim 27 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form. Claim 27 requires the composition of claim to further comprise an ingredient selected from a group comprising shea butter and macadamia seed oil among others. Shea butter and macadamia seed oil are already contained in claim 1, thus claim 27 fails to further limit the base claim.

Claim 27 is also objected to as it also contains repetitive limitations, including propylparaben, methylparaben, cetyl alcohol, tocopheryl acetate, and menthol. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 7, 8, 11, 12, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vatter (US 6224888 B1) in view of Wadsworth (WO 01/15537 A1) and Ferrari et al. (US 6402408 B1).**

Vatter teaches lipstick composition comprising candelilla wax, ozokerite wax, pigments in castor oil. The lipstick formulation of Example I further contains 4.1 % of beeswax (claim 7), 7 % of lanolin (claim 8). Using sorbitan esters as an emollient emulsifier is taught in col. 5, lines 43 – 60. Further adding suitable emollient oils that impart viscosity, “tackiness and drag properties” is also suggested in col. 6, lines 18 – 33. The suitable oils include shea butter, jojoba oil, lanolin, isopropyl palmitate, isopropyl myristate, tocopheryl acetate, tocopheryl linoleate, and plant-based triglycerides, etc. See instant claims 1 and 27. Vatter further teaches using up to about 90 %, more preferably from 1-50%, even more preferably from about 5-40 % of

solidifying agents to solidify a liquid base materials to be used in a cosmetic composition See col. 8, lines 11 – 30. Paraffin wax is mentioned in col. 8, line 40. See instant claim 22. Using paraffin wax, which is another name for white petrolatum, to solidify the cosmetic composition as taught by the reference would have been obvious.

While Vatter teaches using essential oils from plants as emollient oils, the reference fails to teach *Morinda citrifolia* seed oil and macadamia oil.

Wadsworth teaches using *Morinda citrifolia* seed oil as an antioxidant for various applications including making cosmetics. See p. 4, lines 21 – 25.

Vatter and Wadsworth do not specifically teach the amount of the essential oil to use in a cosmetic.

Ferrari teaches that it is a well-known practice in cosmetic art to use additives such as antioxidants or essential oils, particularly for lipstick formulations, in the concentration of up to 20 or 10 % by weight of the total weight of the composition. See col. 7, lines 11 - 22. The reference also teaches macadamia oil contains a high content of triglyceride suitable for cosmetic formulations. See col. 6, line 48.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Vatter by further incorporating *Morinda citrifolia* seed oil as motivated by Wadsworth because Vatter teaches incorporating essential oils from plants and Wadsworth teaches using *Morinda citrifolia* seed oil as an antioxidant for cosmetics. Since Ferrari teaches essential oils or antioxidants are conventionally used in an amount up to 20 or 10 % by weight, the skilled artisan would have had a reasonable expectation of successfully producing a stable lipstick

composition with improved antioxidant property. Further incorporating macadamia oil to the cosmetic of Vatter would have been also obvious in view of Ferrari because both of the references teach using plant-based hydrocarbon oils to make cosmetic products.

### ***Conclusion***

No claims are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See DE 4426148 A1, teaching shea butter is used in cosmetics including lip sticks to protect and care for the skin; JP 1998-381228, teaching macadamia nut oil is used in lipstick formulations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/  
Primary Examiner, Art Unit 1611